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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/449,976	11/26/1999	SATORU MAEDA	7217/60194	6965

7590 11/10/2003

JAY H MAIOLI
COOPER & DUNNER LLP
1185 AAVENUE OF THE AMERICAS
NEW YORK, NY 10036

EXAMINER	
BELIVEAU, SCOTT E	
ART UNIT	**PAPER NUMBER**
2614	8

DATE MAILED: 11/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/449,976	MAEDA ET AL.	
	Examiner	Art Unit	
	Scott Beliveau	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3 and 5* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3 and 5* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Miscellaneous

1. Please note that the examiner of record for the prosecution of this application has changed.

Response to Arguments

2. Applicant's arguments with respect to claims 1-3 and 5 have been considered but are moot in view of the new ground(s) of rejection necessitated by the need to address the newly claimed limitations.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the sequential display of the sender's name and subject sequentially at predetermined positions on the screen) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 3 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The recites the limitation "said control means". There is

insufficient antecedent basis for this limitation in the claim. For the purpose of continued examination, the examiner shall presume that "said control means" refers to the "central processing unit".

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schein et al. (US Pat No. 6,388,714).

In consideration of claim 1, the Schein et al. reference discloses a "television receiver" [510/512] comprising a "connection interface" [518] that facilitates a "connection to an external mail server" such as a POP3 server associated with an information provider on the Internet such as America On Line, Prodigy, and the like, "electronic mail means . . . [for]

sending and receiving electronic mail via said connection interface" (Col 19, Lines 31-50), a "display means" [522], a "random access memory"/"display memory" [513], and a "central processing unit"/"superimposing means" [512] (Col 13, Lines 8-34). The reference further suggests that the particular embodiment is not necessarily limited and may be implemented using alternative configurations including those associated with a PC/TV as illustrated in Figure 1 which includes further includes a number of the aforementioned elements (Col 4, Line 11 – Col 5, Line 50).

With respect embodiment "downloading a plurality of electronic mail messages" for storage in "random access memory", the reference discloses that it is operable to "download" and "store" any received data as needed for the maintenance and generation of the program guide via the aforementioned "connection interface" [518] to the Internet (Col 13, Lines 21-34). Accordingly, it is the examiner's opinion that such information pertaining to the "electronic mail messages" is "downloaded" and "stored" in conjunction with the presentation of information in Figures 15 B/C. Alternatively, it would have been obvious to one having ordinary skill in the art at the time the invention was made to "download a plurality of electronic mail messages" in conjunction with the Schein et al. embodiment since it was known in the art to do such on either an as-needed or scheduled basis (see Cooper et al.: Col 2, Lines 8-29).

As illustrated in Figures 15B/C, the "central processor unit" [512] is operable to "read out from the random access memory" [514] (Col 4, Lines 36-46) and "display" the "name of the sender", the "subject of each of the electronic mail", as well as the particular date that the message was received such that it is "superimposed on a television picture for display on said

display means" [726]. Accordingly, the reference illustrates the claimed display in Figure 15B expect for the limitation that "only" the "name of the sender" and the "subject of each of the electronic mail" message is displayed. It would have been obvious to one having ordinary skill in the art at the time the invention was made to remove the aforementioned date, since it has been held that the omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art. *In re Karlson, 136 USPQ 184.* Subsequent to the aforementioned display, the "central processing unit" is operable to "control" the "scrolling" through "each successive electronic mail on said display means" as indicated by the user's inputs (Col 19, Lines 31-50).

Claim 2 is rejected wherein the aforementioned "central processing unit" [512] is operable to "control accepting an electronic mail check command" from the user [540] in order to "to receive the electronic mail means and to display the name of the sender and the title of the electronic mail along with the television picture on said display means" as illustrated in Figures 15 B/C.

Claim 3 is rejected as aforementioned wherein the "control means" [512] is implicitly operable to direct to "receive each new successive electronic mail and automatically to display the name of the sender and the subject thereof along with the television picture on said display means" in conjunction with the user request to "check new messages".

8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schein et al. (US Pat No. 6,388,714) in view of applicant's admitted prior art.

In consideration of claim 5, the Schein et al. reference discloses accepting a command for displaying a detail or body of the e-mail message as illustrated in Figure 15C. The reference does not explicitly disclose nor preclude that the message illustrated may not be modified to utilize the entire screen of the display as recited in the claim. The applicant's discloses that it is known in the art to provide an electronic mail message on a full screen of the television screen so as to enable the user to appropriately read the detail information or body of the email message (IA: Page 1). Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the invention, if necessary, to include displaying the e-mail on an entire screen of the display for advantage of enabling the user to appropriately read the detail information or body of an e-mail message.

9. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Belamy et al. (US Pat No. 6,209,025), in view of Foladare et al (US Pat No. 5,905,777).

In consideration of claim 1, the Bellamy et al. reference generally discloses a "television receiver" that facilitates the integration of Internet services and telephony services comprising a "connection interface for connecting to an external mail server" [13/14], an "electronic mail means" (Col 7, Lines 26-35), a "display means for displaying a television picture", a "central processing unit" [20] (Col 3, Line 64 – Col 5, Line 15), and a "display memory" (Col 4, Lines 33-37 and 50-51). The reference subsequently discloses that the PC [10] is operable to "download a plurality of electronic mail from the mail server" and to subsequently utilize "superimposing means for superimposing" [5] an alert as to the receipt of the new message on "a television picture for display on said display" (Col 7, Lines 27-35). The user may subsequently "scroll for each successive electronic mail on said display

means" (Col 4, Lines 12-16). While the reference does not explicitly disclose that the PC [10] comprises "random access memory", the usage of such is well known to those having ordinary skill in the art. Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the invention to utilize "random access memory" in conjunction with the PC [10] for the purpose of providing a storage medium for the "downloaded email message".

The reference, however, does not disclose nor preclude the composition of the alert such that it does not comprise "only the name of the sender and the subject of each of the electronic mail" nor does it particularly disclose the usage of "random access memory". The Foladare et al. reference suggests an alert method wherein "only the name of the sender and the subject of each of the electronic mail" is utilized (Col 2, Lines 51-67). Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the invention to utilize the message alert teachings of Foladare et al. in conjunction with the Bellamy embodiment for the purposes of providing a means by which users may be alerted in time efficient manner such that they may quickly ascertain if a message is of importance (Foladare et al.: Col 1, Lines 31-40).

10. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Belamy et al. (US Pat No. 6,209,025), in view of Cooper et al. (US Pat No. 6,052,442).

In further consideration of claim 1, the Bellamy et al. reference generally discloses a "television receiver" that facilitates the integration of Internet services and telephony services comprising a "connection interface for connecting to an external mail server" [13/14], an "electronic mail means" (Col 7, Lines 26-35), a "display means for displaying a television

picture", a "central processing unit" [20] (Col 3, Line 64 – Col 5, Line 15), and a "display memory" (Col 4, Lines 33-37 and 50-51). The reference subsequently discloses that the PC [10] is operable to "download a plurality of electronic mail from the mail server" and to subsequently utilize "superimposing means for superimposing" [5] an alert as to the receipt of the new message on "a television picture for display on said display" (Col 7, Lines 27-35).

The Cooper et al. reference discloses an internet answering machine that may be embodied as a computer (Col 1, Lines 19-23) comprising a "random access memory"/"display memory" (Col 4, Lines 54-67) wherein messages are downloaded and an alert displayed [16] comprising the type of message, the time of the message, the date of the message, "the name of the sender and the subject of each of the electronic mail" (Figure 4). The user may subsequently "scroll through" the aforementioned listings (Col 10, Lines 22-23). Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the Bellamy et al. embodiment using the teachings of the Cooper et al. reference for the purpose of providing a means by which an integrated inbox may display voice, email and fax messages and options for processing each (Bellamy et al.: Col 7, Lines 60-63; Cooper et al.: Col 2, Lines 31-35).

The combined Bellamy et al. and Cooper et al. references, however, do not explicitly disclose that "only the name of the sender and the subject of each of the electronic mail" is displayed in conjunction with the alert. It would have been an obvious matter of design choice to "read"/"display . . . only the name of the sender and the subject of each of the electronic mail", since applicant has not disclosed that the usage of "only the name of the sender and the subject of each of the electronic mail" solves any stated problem or is for any

particular purpose and it appears that the invention would perform equally well in displaying any or all of email information associated with a message header.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as follows. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made.

- The Krisbergh et al. (US Pat No. 5,999,970) reference discloses an access system and method for providing interactive access to an information source that provides electronic mail through a television distribution system.
- The Handelman (US Pat No. 6,634,028) reference discloses a CATV system that is operable to provide electronic mail messages alongside an alert notifying the subscriber as to its presence.
- The Takahashi (US Pat No. 6,308,329) reference discloses a display device that is operable to display push type data in a scrolling fashion.
- The Mandalia (US Pat No. 6,36,890) reference discloses a method for delivering electronic mail messages over a cable television distribution network wherein a user may scroll through the received messages.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 703-305-4907. The examiner can normally be reached on Monday-Friday from 9:00 a.m. - 6:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 703-305-4795. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-HELP.

SEB
October 24, 2003

JOHN MILLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600